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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,405	03/16/2004	Robert Senn	PI/5-20835C/D1	5092

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SYNGENTA CROP PROTECTION, INC.  
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EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT PAPER NUMBER

1616

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/801,405	<b>Applicant(s)</b> SENN ET AL.	
	<b>Examiner</b> Alton N. Pryor	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 20 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☐ Claim(s) 1-10, 17-20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-10, 17-20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

**I. Rejection of claims 1-10,17-20,22 under 35 USC 112, 1<sup>st</sup> paragraph will be maintained in light of amendment filed 10/20/05 for reason on record and reason as follows. New claims 23 and 24 are added to this rejection.**

Applicant argues that the specification discloses that compounds of formula (A) are known in the art. Applicant refers examiner to EP-A-580553 and Canadian Patent 2100924. Examiner argues that specification and references do not show in examples a considerable number of the compounds of instant formula (A) functioning as an insecticide. Note, the definition of A in compound of formula (A) is too board. A is defined as being a) aromatic monocyclics and bicyclics which includes numerous aromatic mono- and bi- cyclic hydrocarbons and aromatic heterocyclics, or b) non-aromatic monocyclics and bicyclics which includes numerous non-aromatic mono- or bi-cyclic hydrocarbons and heterocyclic compounds. The specification is not enabling for all of these compounds functioning as an insecticide when used in combination with abamectin.

**II. Rejection of claims 1-10,17,19 under 35 USC 103(a) as being obvious over Moriie (JP 07224062) and Baranowski will be maintained for reason on record and reason as follows.**

A) Applicant argues:

Moriie reference is to the preparation of nitroiminotetrahydro-oxadiazine as an insecticide falling within the scope of formula (A).

Moriie specifically discloses the use of the compounds for control of

*Myzus persicae*; whereas, Baranowski is directed to avermectins such as abamectin which is a selective insecticide. Baranowski teaches that abamectin is not disruptive to natural predators or beneficial insects. Accordingly, there is no motivation to combine the references.

B) Examiner argues:

There exist ample motivation to combine references having the same utility, because the resulting combination would have been expected to at least yield an additive effect and/or broaden the effectiveness of the composition when actives are used together as opposed to alone. Note that Morie teaches that nitroiminotetrahydro-oxadiazine is an insecticide, and Baranowski teaches that abamectin is an insecticide. Although the two compounds may have different modes of action, they are both classified generally as insecticides and it is obvious to combine actives having the same utility. The combination of the insecticides would have been expected to yield an enhanced result whether it is an additive effect or broaden activity effect.

**III. Rejection of claims 1-10,17,19 under 35 USC 103(a) as being obvious over Matsuo (JP 082911471) and Baranowski will be maintained for reason on record and reason as follows.**

A) Applicant argues:

Matsuo reference is to the preparation of nitroiminotetrahydro-oxadiazine as insecticide falling within the scope of formula (A). Matsuo specifically discloses the use of the compounds for control of *Laodelphas striatellus*, *Nephotettix cincticeps*, and *Spodoptera*; whereas, Baranowski is directed to avermectins such as abamectin which is a selective insecticide. Baranowski teaches that abamectin is not disruptive to natural predators or beneficial insects. Accordingly, there is no motivation to combine the references.

A) Examiner argues:

There is exist ample motivation to combine references having the same utility because the resulting combination would have been expected to at least yield an additive effect and/or broaden the effectiveness of the composition when actives are used together as opposed to alone. Note that Matsuo teaches that nitroiminotetrahydro-oxadiazine is an insecticide and Baranowski teaches that abamectin is an insecticide. Although the two compounds may have different modes of action, they are both classified generally as insecticides and it is obvious to combine actives having the same utility. The combination of the insecticides would have been expected to yield an enhanced result whether it is an additive effect or broaden activity effect.

#### **IV. Claim Objection**

Claims 20 and 24 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. A claim to a material should not depend from a claim to a method.

#### ***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Alton Pryor

Primary Examiner

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